IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPEAL FROM THE EXAMINER
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Susann Marie Keohane	)	Confirmation No.: 8940
	)	
Serial No.: 10/666,816	)	Examiner: Dailey, Thomas J.
	)	
Filing Date: September 18, 2003	)	Group Art Unit: 2452
	)	
Title: A METHOD OF RESCINDING	)	Docket No.: AUS920030442US1
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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed March 3, 2009. Appellant filed a Notice of Appeal on June 3, 2009. Appellant respectfully submits herewith this Appeal Brief with authorization to charge the statutory fee of $540.00.

REAL PARTY IN INTEREST

International Business Machines, Inc. is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1 and 3-10 stand rejected pursuant to a final Office Action mailed March 3, 2009 (hereinafter referred to as the "Final Office Action"). Claim 2 and 11-40 have been cancelled without prejudice or disclaimer. Claims 1 and 3-10 are presented for appeal.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the mailing of the Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1

Embodiments of the present application as defined by independent Claim 1 are directed toward a method of rescinding previously transmitted e-mail messages by a sender, the messages being addressed to a list of recipients, the method comprising storing an e-mail message addressed to a list of recipients on a computing system (see specification, page 3, lines 5-10; page 11, line 29 to page 12, line 7; page 16, lines 4-15; see reference numbers 104, 108, 110 and 112 in FIG. 1; and see reference numbers 804, 806, 808, 810 and 812 in FIG. 8). The method also comprises generating a notification message, the notification message for allowing recipients from the list of recipients and the sender to access the stored e-mail message and sending the notification message to the recipients from the list of recipients and to the sender (see specification, page 3, lines 5-16; page 11, line 29 to page 12, line 7; page 13, lines 3-22; page 16, lines 4-23; see reference numbers 804, 806, 808, 810 and 812 in FIG. 8; and see reference numbers 904, 906, 912 and 914 in FIG. 9). The method further comprises determining whether one of the recipients from the list of recipients has accessed the stored e-mail message (see specification, page 13, line 23 to page 14, line 5, page 14, line 23 to page 15, line 3; and see reference numbers 1004, 1006 in FIG. 10) and enabling the sender, if one of the recipients from

the list of recipients has accessed the stored e-mail message and using the notification message, to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message (see specification, page 13, line 14 to page 14, line 15; page 14, line 23 to page 15, line 3; page 17, lines 13-28; and see reference numbers 1006, 1008, 1010, 1012, 1014, 1016 and 1018 in FIG. 10).

Independent Claim 7

Embodiments of the present application as defined by independent Claim 7 are directed toward a method of modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients, the method comprising storing the e-mail message on a computing system (see specification, page 3, lines 5-10; page 11, line 29 to page 12, line 7; page 16, lines 4-15; see reference numbers 104, 108, 110 and 112 in FIG. 1; and see reference numbers 804, 806, 808, 810 and 812 in FIG. 8). The method also comprises generating a notification message, the notification message for allowing recipients from the list of recipients and the sender to access the stored e-mail message, and sending the notification message to the recipients from the list of recipients and to the sender (see specification, page 3, lines 5-16; page 11, line 29 to page 12, line 7; page 13, lines 3-22; page 16, lines 4-23; see reference numbers 804, 806, 808, 810 and 812 in FIG. 8; and see reference numbers 904, 906, 912 and 914 in FIG. 9). The method further comprises enabling the sender to modify the stored e-mail message using the notification message (see specification, page 13, lines 14-22) wherein the enabling step includes determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message (see specification, page 14, line 16 to page 15, line 3, and page 17, lines 13-32), displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message (see specification, page 14, line 23 to page 15, line 3; and page 17, lines 13-32), allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message (see specification, page 14, line 23 to page 15, line 3; and page 17, lines 13-32), and replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message (see specification, page 14, line 23 to page 15, line 3; and page 17, lines 13-32).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 7-9 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of EP Patent Publication No. 1,087,321 issued to Brogne (hereinafter *"Brogne"*) and in view of U.S. Patent No. 5,930,471 issued to Milewski et al. (hereinafter *"Milewski"*).

2. Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of *Brogne* and in view of U.S. Patent No. 5,870,548 issued to Nielsen and in further view of *Milewski*.

3. Claim 10 stands rejected under 35 USC §103(a) as allegedly being unpatentable over *Brogne* and *Milewski* as applied to claim 7 and further in view of what is alleged as being well known in the art.

4. Claims 4-6 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Brogne* and *Nielsen* in view of *Milewski* as applied to claim 1 and further in view of what is alleged as being well known in the art.

ARGUMENT

A. Standard
35 U.S.C. § 103

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. §103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Additionally, all limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Therefore, no *prima facie* obviousness rejection can be established if the proposed combination does not teach all of the features of the claimed invention. Additionally, rejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. __, __, 82 U.S.P.Q.2d 1385, 1396 (2007).

B. Argument

1. Rejection under 35 U.S.C. §103 in view of *Brogne and Milewski*

Claims 7-9 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of *Brogne* and *Milewski*. Appellant contends that Claims 7-9 are patentable over the cited *Brogne* and *Milewski* references. Of the rejected claims, Claim 7 is independent.

Independent Claim 7 recites, at least in part, "**determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message**," "**displaying the list of recipients** and a copy of the stored e-mail message to the sender **wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion** from recipients that have not already accessed the stored e-mail message" and "**allowing the sender to modify the displayed copy of the stored e-mail message** and to send the modified copy to the recipients **that have not already accessed the stored e-mail message**" (emphasis added).

Brogne recites the following regarding the ability of the sender to access the e-mail message:

> The **condition for the modification to be accepted by the server is that none of its addressees has read the sent e-mail**, when the sender wants to manipulate the sent e-mail.

(*Brogne*, abstract) (emphasis added). *Brogne* also recites:

> If the server receives a modification message dedicated to modify the stored e-mail body, this modification is executing according to the content of the modification message **only if the e-mail body has not been accessed by any of the addressees**.

(*Brogne*, paragraph 0010 (column 2, lines 21-25)) (emphasis added). *Brogne* further recites:

> A particular object of the present invention is to provide a method of manipulating an already sent e-mail addressed by a sender to an addressee, so that the sender can retract or modify the already sent e-mail **as long as the addressee of the e-mail has not accessed it**.

(*Brogne*, paragraph 0008 (column 2, lines 1-6) (emphasis added).

The Examiner appears to assert that *Brogne* discloses the above-referenced features of Claim 7 (Final Office Action, page 7). Appellant respectfully disagrees. As indicated above,

Brogne allows modification of an e-mail message **only** if no recipient has accessed the e-mail message. Therefore, for at least this reason, *Brogne* does not disclose what is relied on by the Examiner to reject Claim 7. Additionally, the Examiner appears to assert that Claim 7 does not take into account whether at least one recipient has accessed the e-mail message and, therefore, if none have accessed the e-mail message, the features of Claim 7 alleged to be disclosed by *Brogne* have been met (Final Office Action, pages 2 and 3). Appellant respectfully disagrees. As indicated above, Claim 7 recites "**displaying the list of recipients** and a copy of the stored e-mail message to the sender **wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion** from recipients that have not already accessed the stored e-mail message" (emphasis added). Appellant contends that Claim 7 does take into account those recipients that have accessed the e-mail message as Claim 7 recites that those that have accessed the e-mail message are displayed in a distinguished fashion from the recipients that have not already accessed the e-mail message. Thus, Appellant contends that neither *Brogne* nor *Milewski*, alone or in combination, discloses at least the features of Claim 7 as discussed above. In fact, *Brogne* clearly teaches away from the features recited by Claim 7.

Further, Claim 7 recites, at least in part, "generating a notification message, the notification message for allowing recipients from the list of recipients and the sender to access the stored e-mail message," "sending the notification message to the recipients from the list of recipients and to the sender," "enabling the sender to modify the stored e-mail message **using the notification message**" and "allowing the sender to modify the displayed copy of the stored e-mail message and to **send the modified copy to the recipients that have not already accessed the stored e-mail message**" (emphasis added). The Examiner appears to acknowledge that *Brogne* does not disclose that the notification message enables the sender to modify the stored e-mail message as recited by Claim 7 (Final Office Action, page 7). The Examiner appears to rely on *Milewski* to remedy this deficiency of *Brogne* (Final Office Action, page 8). Appellant respectfully disagrees and submits that the references, even if combined, fail to disclose at least the above-referenced feature of Claim 7.

FIG. 6 of *Milewski* appears to disclose a form 600 indicating the status of a message distributed to the recipients. *Milewski* appears to disclose that the form 600 includes a field 614 for deleting the message (*Milewski*, column 8, lines 22-24, figure 6). Thus, *Milewski* does not appear to enable the sender to access the stored message or to modify the stored message. To the contrary, *Milewski* appears to disclose that the sender may only delete the message. In fact, *Milewski* appears to disclose that only a pointer message is sent to the sender of the e-mail ("In operation 711, the controller confirms the dispatch of the pointer message to the recipients and provides the sender with a pointer to status information regarding the content of the virtual mailbox." (*Milewski*, column 8, lines 61-64)). Thus, neither the pointer message nor the status information of *Milewski* enables the sender to access the stored e-mail message. Further, even if deleting the message was considered to be accessing the stored message, which Appellant respectfully disagrees, there would be no message to thereafter send to the recipients that have not already accessed the message. Thus, even if combined, the cited references do not appear to disclose "enabling the sender to modify the stored e-mail message using the notification message" and "allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message" as recited by Claim 7 (emphasis added).

Moreover, the Examiner appears to assert that *Milewski* discloses that the notification message of *Milewski* sent to the sender displays the list of recipients and distinguishes between those recipients that have accessed the e-mail message from those recipients that have not yet accessed the e-mail message (Final Office Action, page 8). Appellant respectfully disagrees. *Milewski* appears to disclose a transaction summary form 600 having a field 606 indicating a response count and type of response provided by the recipients to the message (*Milewski*, column 8, lines 8-19). *Milewski* also appears to disclose that the transaction summary form 600 includes a field 610 listing the recipients who have not **answered** the message (*Milewski*, column 8, lines 15-22). Appellant respectfully submits that an "answer" to a message does not equate to whether a recipient has "accessed" a message. Indeed, a recipient may have accessed a message but not yet answered the message. *Milewski* does not appear to display or provide any indication whether a recipient has accessed a message. Therefore, *Milewski* does not disclose "displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message

are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message" as recited by Claim 7. Accordingly, even if combined, *Brogne* and *Milewski* fail to disclose all of the features of Claim 7.

Additionally, the Examiner appears to rely on *Brogne* for teaching "storing the e-mail message on a computing system" as recited by Claim 7 (Final Office Action, page 6). *Brogne* appears to disclose that the e-mails are sent to a server which stores the mail body together with an access code and that a notification message containing the access code is sent to the addressees (*Brogne*, column 2, lines 15-19). The Examiner appears to rely on *Milewski* to teach generating a notification message, sending the notification message to the recipients and the sender, and using the notification message to indicate to the sender which recipients have accessed the message and which recipients have not accessed the message (Final Office Action, page 8). As indicated above, *Milewski* does not indicate which recipients have or have not accessed the e-mail message. Further, *Brogne* appears to disclose that once one recipient has accessed the e-mail message, the e-mail message is automatically sent from the server to all remaining recipients, and the message is deleted from the server (*Brogne*, column 7, lines 41-52). *Brogne* recites:

> Once means 49 have downloaded the e-mail body to one addressee having requested it, means 46 accesses the database 42 to construct and send automatically an e-mail containing the e-mail body to all other e-mail addressees. When the e-mails have been automatically sent to all the other e-mail addressees, the corresponding database entry may be deleted.

(*Brogne*, column 7, lines 45-51). Thus, *arguendo*, even if the notification message of *Milewski* is considered to display which recipients are determined to have accessed the e-mail message, such access by one recipient would appear to result in the e-mail message being automatically sent to the remaining recipients and the e-mail body deleted from the server, thereby resulting in the e-mail message no longer being accessible by the sender to modify. Therefore, the combination of references does not disclose the features of Claim 1, and further, *Brogne* clearly teaches away from the combination/modification proposed by the Examiner.

Accordingly, for at least for the reasons discussed above, Appellant respectfully submits that Claim 7, and Claims 8 and 9 that depend therefrom, are patentable over the *Brogne* and *Milewski* references.

2. Rejection under 35 U.S.C. §103 in view of *Brogne, Nielsen and Milewski*

Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of *Brogne, Nielsen* and *Milewski*. Appellant contends that Claims 1 and 3 are patentable over the cited *Brogne, Nielsen* and *Milewski* references. Of the rejected claims, Claim 1 is independent.

Independent Claim 1 recites, at least in part, "generating a notification message, the **notification message for allowing** recipients from the list of recipients and the **sender to access the stored e-mail message**," "sending the notification message to the recipients from the list of recipients and to the sender," "determining whether one of the recipients from the list of recipients has accessed the stored e-mail message" and "enabling the sender, **if one of the recipients from the list of recipients has accessed** the stored e-mail message and **using the notification message**, to **preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message**" (emphasis added).

In the Final Office Action, the Examiner appears to acknowledge that, even if combined, *Brogne* and *Nielsen* fail to disclose enabling the sender, using the notification message, to preclude one of the recipients that have not yet accessed the stored e-mail message from accessing the e-mail message as recited by Claim 1 (Final Office Action, page 12). The Examiner appears to rely on *Milewski* to remedy this deficiency of *Brogne* and *Nielsen* (Final Office Action, page 12). Appellant respectfully submits that *Milewski* also fails to disclose the above-referenced feature of Claim 1.

As indicated above, *Milewski* appears to disclose a transaction summary form 600 having a field 606 indicating a response count and type of response provided by the recipients to the message (*Milewski*, column 8, lines 8-19). *Milewski* also appears to disclose that the transaction summary form 600 includes a field 610 listing the recipients who have not answered the message (*Milewski*, column 8, lines 15-22). *Milewski* also appears to indicate that the transaction

summary form includes a field 610 for sending a reminder message to the recipient, and a field 614 for deleting the message (*Milewski*, column 8, lines 20-25). Thus, *Milewski* does not appear to enable the sender to access the stored message. To the contrary, *Milewski* appears to disclose that the sender may only delete the message. In fact, *Milewski* appears to disclose that only a pointer message is sent to the sender of the e-mail ("In operation 711, the controller confirms the dispatch of the pointer message to the recipients and provides the sender with a pointer to status information regarding the content of the virtual mailbox." (*Milewski*, column 8, lines 61-64)). Thus, neither the pointer message nor the status information of *Milewski* enables the sender to access the stored e-mail message. Accordingly, even if combined, *Brogne*, *Nielsen* and *Milewski* fail to disclose all of the features of Claim 1.

Accordingly, for at least for the reasons discussed above, Appellant respectfully submits that Claim 1, and Claim 3 that depends therefrom, are patentable over the cited references.

3. Rejection under 35 U.S.C. §103 in view of *Brogne* and *Milewski*

Claim 10 stands rejected under 35 USC §103(a) as being unpatentable over *Brogne* and *Milewski* as applied to claim 7 and further in view of what is well known in the art.

Claim 10 depends from independent Claim 7. As indicated above, Appellant contends that Claim 7 is patentable over the *Brogne* and *Milewski* references. Therefore, for at least this reason, Claim 10 that depends from Claim 7 is also patentable.

4. Rejection under 35 U.S.C. §103 in view of *Brogne, Nielsen* and *Milewski*

Claims 4-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Brogne* and *Nielsen* in view of *Milewski* as applied to claim 1 and further in view of what is well known in the art.

Claims 4-6 depend from independent Claim 1. As indicated above, Appellant contends that Claim 1 is patentable over the *Brogne, Nielsen* and *Milewski* references. Therefore, for at least this reason, Claims 4-6 that depend from Claim 1 are also patentable.

CONCLUSION

Appellant has demonstrated that the present claims are clearly distinguishable over the art cited of record. Therefore, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner.

The Commissioner is authorized to charge the statutory fee of $540.00 to Deposit Account No. 09-0447 of IBM Corporation, referencing Attorney Docket No. AUS920030432US2. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 09-0447 of IBM Corporation, referencing Attorney Docket No. AUS920030432US2.

Respectfully submitted,

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Date: August 3, 2009

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APPENDIX A – CLAIMS ON APPEAL

1. A method of rescinding previously transmitted e-mail messages by a sender, the messages being addressed to a list of recipients, the method comprising:

storing an e-mail message addressed to a list of recipients on a computing system;

generating a notification message, the notification message for allowing recipients from the list of recipients and the sender to access the stored e-mail message;

sending the notification message to the recipients from the list of recipients and to the sender;

determining whether one of the recipients from the list of recipients has accessed the stored e-mail message; and

enabling the sender, if one of the recipients from the list of recipients has accessed the stored e-mail message and using the notification message, to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message.

3. The method of Claim 1 wherein the e-mail message has a text portion, the sender being allowed to modify the text portion.

4. The method of Claim 3 wherein the stored e-mail message is encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.

5. The method of Claim 4 wherein the computing system is the computing system on which the stored e-mail message was composed.

6. The method of Claim 4 wherein the computing system is a server, the server generating and sending the notification message to the recipients and sender.

7. A method of modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients, the method comprising:

storing the e-mail message on a computing system;

generating a notification message, the notification message for allowing recipients from the list of recipients and the sender to access the stored e-mail message;

sending the notification message to the recipients from the list of recipients and to the sender; and

enabling the sender to modify the stored e-mail message using the notification message wherein the enabling step includes:

determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message;

displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message;

allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message; and

replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message.

8. The method of Claim 7 wherein the stored e-mail message has a text portion, the text portion being modified by the sender.

9. The method of Claim 7 wherein the list of recipients is modified by the sender by adding new recipients to the list or deleting recipients from the list.

10. The method of Claim 7 wherein the stored e-mail message is encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.

APPENDIX B – EVIDENCE

There is no evidence entered by the Examiner and relied upon by Appellant in this appeal.

APPENDIX C - RELATED PROCEEDINGS

There are no proceedings identified in the "Related Appeal and Interferences" section.